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EXAMINER

WACHTEL, ALEXIS A

ART UNIT PAPER NUMBER

1764

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/821,453

Applicant(s)

SHAW ET AL.

Examiner

Alexis Wachtel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

**Detailed Action**

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2,4-6,8,9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 2 recites the phrase "mineral fibers of the fiberglass or rock fibre type".  
What does Applicant mean by type?

4. Claim 16 recites the limitation "bound", and "unbound". There is insufficient antecedent basis for this limitation in the claim. In addition, it isn't clear what element of the device these terms are intended to modify.

5. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74

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(Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). Claims 4,5,6,8-10 recites the recitation "in particular".

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5,7,8,9,10 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 1235463.

GB 1235463 describes a method of absorbing oil with a mass of inorganic fibers for example glass fibers, slag wool fibers and mineral wool fibers such as rock-wool fibers that are in a mat form. The oil absorbing mat can absorb up to 15 times by weight of oil (front page, right column, 50-70). The fibers are coated with a water repellent agent. Said water repellent agent greatly enhances the efficiency of absorption of oil relative to water by the fibers (front page, right column, 83-90). Silicone can be applied in emulsion form to the fibers in amounts of 0.5 to 2% by weight of the water repellent agent (Col 1, lines 1-12). The oil absorbing mat can be used for absorbing oil spilled at sea (Col 1, lines 59-64 and Col 3, lines 5-7).

Although GB 1235463 does not explicitly teach the claimed viscosity range of the oleophilic coating, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. silicone oil emulsion) and in the similar production steps (i.e. applying silicone as a coating) used to produce the oil absorbent mat. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed

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viscosity range would obviously have been provided by the process disclosed by GB 1235463. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

10. Claims 1-4,8,9,12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 4,006,079 to Langlois et al.

Langlois et al teaches a method of removing oil from the surface of water contaminated with oil when oil is spilled from an oil hauling vessel comprising floating elongated blankets of non-woven discontinuous glass fibers on the surface of the oil-contaminated water to absorb the oil, the glass fibers having been sprayed with silicone oil as a hydrophobic oleophilic agent solely before curing of the binder used in the nonwoven (Col 2, lines 53-68).

Although Langlois et al does not explicitly teach the claimed viscosity range of the oleophilic coating, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. silicone oil, oil absorbing nonwoven) and in the similar production steps (i.e. applying silicone to nonwoven) used to produce the oil absorbent nonwoven. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed viscosity range would obviously have been provided by the process disclosed by Langlois et al. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102.

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12. Claims 1-3 and 13-19 are rejected under 35 U.S.C. 102(e) or (a) as being anticipated by US 6,180,233 to Shaw.

Shaw discloses a sorbent glass fiber material useful for sorbing spills of water and water-soluble liquids. The sorbent material includes glass fibers combined with hydrophilic absorbent particles. The particles can be made from polymers having hydrophilic groups such as crosslinked polyacrylamide, crosslinked sulfonated polystyrene, crosslinked polyacrylate and the like. The glass fibers can be bindered or unbindered (Abstract). In addition, hydrocolloidal material can be used (Col 2, lines 59-67). The particles can be present in amounts of 5 to 20% by weight based on the glass fiber material. The particles size can be in the range of 50 to 300 micrometers (Col 3, lines 10-20). The sorbent can be used to absorb water soluble pollutants (Col 4, lines 9-19). Examiner notes that known examples of water soluble pollutants include paint. The particles can be homogenously mixed with the glass fibers by mixing or agitation (Col 3, lines 26-41).

13. Claims 1,13-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,429,001 to Kolpin et al.

Kolpin et al discloses a coherent web of entangled blown fibers having super absorbent polymeric particles dispersed within the web (Abstract). The super absorbent particles are made of the claimed materials and can up absorb between 20 to 100 times their weight in water. The particles are 75 to 15 micrometers in diameter (Col 5, lines 1-23).

***Claim Rejections - 35 USC § 103***

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14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1,6,9,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,215,407 to Brelsford in view of GB 1235463.

Brelsford teaches a process of cleaning spills of toxic or hazardous materials such as oil, wherein the process comprises spraying shredded fiberglass blowing wool onto the spill and absorbing the spill with the fiberglass blowing wool composition (Abstract). On application of the shredded fiberglass to a polluted area for absorptive purposes, the shredded fiberglass may be sprayed with a fine mist of an antifreeze and water solution to reduce the dust given off by the shredded fiberglass as it's being sprayed onto the oil spill (Col 3, lines 24-30). Brelsford as set forth above fails to teach that the shredded fiberglass can be coated with silicone. GB 1235463 is directed to oil absorbing mats and teaches that water repellents such as silicone oil can be applied to the mat fibers in order to improve oil absorption efficiency (Front page, right column, lines 83-90, and Col 1, lines 1-10). In view of this teaching it would have been obvious for one of ordinary skill to have applied a silicone coating the shredded fiberglass motivated by the desire to improve the oil absorptive properties of the said shredded fiberglass.



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**Conclusion**

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alex Wachtel, whose number is (703)-306-0320. The Examiner can normally be reached Mondays-Fridays from 10:30am to 6:30pm.

If attempts to reach the Examiner by telephone are unsuccessful and the matter is urgent, the Examiner's supervisor, Mr. Terrel Morris, can be reached at (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Eliagabets m Cole*  
E. ELIAGABETS M. COLE  
PATENT EXAMINER